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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,138	04/23/2001	Masaki Hiraga	1341.1091/JDH	1608
21171 7590 11/15/2007 STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER NGUYEN, TRI V	
			ART UNIT 1796	PAPER NUMBER
			MAIL DATE 11/15/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/839,138

Applicant(s)

HIRAGA, MASAKI

Examiner

Tri V. Nguyen

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.138(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 11-13, 16 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 11-13, 16 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Request for Continued Examination

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/26/07 has been entered.

Response to Amendment

2. Upon the amendment filed on 08/28/07, Claims 1, 11-13, 16 and 22 are amended and Claims 9, 10, 14, 15 and 17-21 are cancelled. The currently pending claims considered below are Claims 1-8, 11-13, 16 and 22.

In view of amendment and remarks, the rejections under 112, second paragraph, and the rejection under 103(a) over Ng in view of Rothstein are withdrawn.

Claim Rejections - 35 USC § 102

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claim 22 is rejected under 35 U.S.C. 102(e) as being anticipated by Ng (US 6,405,175).

Claim 22: Ng discloses a method for providing points based on a retrieval of keywords, comprising:

- a. providing information to a first user in response to a requested search corresponding to keywords (col 5, line 21 to col 6, line 51—the products/services reviewed are considered as the keywords); and

b. assigning at least one point to a second user in response to any of the keywords being selected and registered, by the second user, from a keywords previously presented to the second user, the selected keywords having been accepted and associated with the provided information (col 6, lines 37-45 and col 8, lines 33-49).

Patentee's presentation of the category to the reviewer is commensurate to applicants' presentation of keywords (col 6, lines 37-45).

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-3, 8, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ng (US 6,405,175) in view of Davis et al. (US 6,654,725).

Claim 1: Ng discloses a method of providing points based on a retrieval of keywords, the method comprising:

- a. presenting keywords to a first user through a network (col 6, lines 37 - 45 -- the presentation of categories for products is commensurate to the presentation of keywords);
- b. accepting, from the first user, a selection of at least one of the keywords presented to the first user (col 6, lines 37 - 45);
- c. storing keywords selected from the presented keywords by the first user into a user-by-keyword management table relating to the user (col 5, line 21 to col 6, line 51—the products/services reviewed are considered as the keywords);
- d. presenting keywords to an advertiser through the network;
- e. accepting, from the advertiser, a selection of at least one of the keywords presented

to the advertiser;

f. storing keywords selected by the advertiser into an advertiser-by-keyword management table relating to the advertiser;

g. searching the user-by-keyword management table and the advertiser-by-keyword management table for keywords when there has been a request for retrieving the keywords from a second user different from the first user through the network, and when the requested keywords have been registered both in the user-by-keyword management table and the advertiser-by-keyword management table, posting a retrieved result of the keywords and advertisement of the corresponding advertiser to the second user through the network (col 8, lines 33-49); and

h. giving points to the first user when the second user has referred to the advertisement, and storing these points into a user's-point management table relating to the first user (col 8, lines 33-49).

Ng does not explicitly disclose steps of interacting with the advertiser and displaying the advertisement along with the search results. Ng discloses the use of targeted advertising in conjunction with the products and services listed and searched (col 15, lines 43-60). Furthermore, Ng teach the feature of a user being rewarded for an advertisement being viewed by a second user (col. 14, lines 52-63 and claim 4). In an analogous art, Davis et al recites the features of targeted advertisement being displayed on a search result web page and specific keywords being presented and selected by the advertiser (abstract, Figs 1, 2 , 9 and parag. 48-60). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Ng with keyword advertising. One would have been motivated to optimize the efficiency of the targeted advertisement by focusing the selection and ensuing delivery of the advertisement to users who are more likely to purchases

the items advertised. The claim would have been obvious because a particular known technique was recognized as part of the ordinary capabilities of a skilled artisan. The claim would have been obvious because the technique for improving a particular method was part of the ordinary capabilities of a person of ordinary skill in the art, in view of the teaching of the technique for improvement in other situations.

Claim 2: Ng and Davis et al disclose the method of providing points according to the claim 1, wherein the points gained by the first user are exchanged for a product or a service (Ng: col 9, lines 23-29).

Claim 3: Ng and Davis et al disclose the method of providing points according to the claim 1, wherein the points comprise user points that are generated when the second user has retrieved the user-obtained keywords and advertiser points that are generated when the second user has referred to the advertisement (Ng: col 5, lines 4-9).

Claim 8: Ng and Davis et al disclose the method of providing points according to the claim 1, but do not explicitly disclose wherein the first user who has registered the keywords can select a display on the Web or a transmission by e-mail as a method of presenting the advertisement to the other users. Davis et al discloses the use of web page as a display means (abstract and parag. 48). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Ng and Davis et al, with displaying the advertisement via a web page since it was known in the art that different display channels are used to enhance the ways to reach the users. The claim would have been obvious because a particular known technique was recognized as part of the ordinary capabilities of a skilled

artisan.

Claims 12 and 13 disclose the apparatus and the computer readable medium of the method Claim 1 respectively. The prior art of et al. as set forth above in Claim 1 is relied upon to reject Claims 12 and 13.

7. Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ng and Davis et al as applied to claim 1 above, and further in view of Marks et al. (US 2001/0051911).

Claims 4-7: Ng and Davis et al disclose the method of providing points according to the claim 1, but do not explicitly disclose the various ways of charging for the keywords. Ng recites the use of heuristic rules to improve the obtained results (col 11, lines 43-60). Davis et al discloses an accounting manager to maintain the records of the transactions and the compensation information (abstract, element 22 in Fig 1 and Fig 2). In an analogous art, Marks et al. recites the use of keyword advertising by associating an ad with specific keywords chosen by the advertiser in a search engine setting that includes different charged rates for each keyword (page 2, parag. 23-28). Furthermore, the fee structure is seen as a design decision which is given little, if any, patentable weight. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Ng and Davis et al to include a fee structure for charging the keywords. One would have been motivated to implement a payment scheme in order to attract advertisers by giving the advertisers a decision choice depending on the revenue, viewing experience and traffic stream pattern. The claim would have been obvious because a particular known technique was recognized as part of the ordinary capabilities of a skilled artisan.

8. Claims 11 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al in view of Ng.

Claim 11: Davis et al discloses a method of providing points based on a retrieval of keywords, the method comprising:

- a. displaying retrieved results of keywords together with advertisement of advertiser corresponding to the keywords at a first user's terminal, when the first user has retrieved the keywords from the user's terminal through a network (abstract and parag. 48-60); and
- b. giving points to a second user who has selected the keywords from the keywords previously presented to the second user, the selected keywords having been accepted and associated with the second user, when the first user has referred to the displayed advertisement.

Davis et al does not explicitly disclose step b. Davis et al discloses compensating a third party for helping in the advertisement display (abstract). In an analogous art, Ng discloses the use of targeted advertising in conjunction with the products and services referred by a first user and searched by a second user (col 5, line 21 to col 6, line 51 and col 15, lines 43-60). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Davis et al with keyword referral. One would have been motivated to optimize the efficiency of the targeted advertisement by compensating the referral effort of a user thus enhancing the delivery of the advertisement to users who are more likely to purchase the items advertised. The claim would have been obvious because a particular known technique was recognized as part of the ordinary capabilities of a skilled artisan.

Claim 16 discloses the computer readable medium of the method Claim 11. The prior art of Davis et al and Ng as set forth above in Claim 11 is relied upon to reject Claim 16.

Response to Arguments

9. Applicant's arguments citing the Rothstein reference have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments filed 1-8, 11-13, 16 and 22 have been fully considered but they are not persuasive.

a. Regarding applicants' argument that the product being reviewed is not commensurate to a keyword (pages 7-8), the examiner respectfully disagrees as both Ng and Davis et al. references disclose the features of a search engine and search terms input thus the search term is construed as a keyword. For example, a skilled artisan would recognize that a consumer interested in a specific brand of product would input the brand and the product name in a search engine and that the entries are keywords.

b. Regarding applicants' argument of presenting the keywords, the examiner notes that Ng discloses the feature of product categories listing being presented to the reviewer (col 5, line 21 to col 6, line 51). Ng's categories listing reads on applicants' keyword presentation.

c. Regarding applicants' argument on the absence of advertiser in the Ng reference, the examiner respectfully disagrees as the Ng reference teaches the features of being rewarding for viewing advertisements thus implying advertisers (col 14, lines 52-63 and claim 4). Furthermore, the Davis et al. reference is relied upon to teach the features of advertising in a search engine context and the keywords selection (abstract).

Conclusion


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri V. Nguyen whose telephone number is (571) 272-6965. The examiner can normally be reached on M-F 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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NVT
11/8/2007


ERIC W. STAMBER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600